



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/817,155 | 03/27/2001 | Masato Hasegawa | 50395-096 | 7094 |

7590 08/08/2006
McDERMOTT, WILL & EMERY
600 13th Street, N. W.
Washington, DC 20005-3096

| |
|----------|
| EXAMINER |
|----------|

LEE, SHUN K

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2884

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/817,155

Applicant(s)

HASEGAWA ET AL.

Examiner

Shun Lee

Art Unit

2884

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 60-104.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.


CONSTANTINE HANNAHER
PRIMARY EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: applicant argues that one skilled in the art reading the original disclosure, would reasonably discern the limitation at issue in the claims since a theoretical transmittance in the presence of a resin coating layer can be calculated utilizing a refractive index and an absorption coefficient and that in an actual operation of coating a resin cover, it is generally considered in the art that the resin layer and the ceramics do not form a complete contact but show a certain gap allowing a slight inclusion of an air layer whereas an air layer is considered absent in the subject application since the coating is executed by flowing a resin into a mold under a high pressure in the injection molding. Examiner respectfully disagrees. First, applicant does not point out where the unstated (e.g., interface quality) and stated (e.g., no air gap) assumptions are supported. For example, the specification discloses (pg. 35, line 17 to pg. 36, line 9) that "Using these measurement data, the arithmetic mean values were calculated in the same manner as in Example 1. ... For all cases, these are average values for 50 samples. Though not shown in the Table, when the samples to which pigment was added were checked for the degree of dispersion R in the base material in the same manner as the ceramics of Example 1, the values of R were within the range of 3 to 4% for all samples". Thus it is clear that the values in the tables are not the raw data but rather summarized data (which lacks statistical analyses). Further the summarized data in the provided tables would not allow a statistical analysis which would allow one of ordinary skill to conclude that any relationship extracted from the summarized data is statistically significant. Thus it is unclear that an analysis (for example by calculating a theoretical transmittance using a refractive index which is assumed to apply to the sample and an absorption coefficient which is assumed to apply to the sample) of the summarized data in the provided tables would lead one of ordinary skill to conclude that "a light-shielding ratio of the lens body, T_i/T_v , is greater than the product of the light-shielding ratio of the ceramic part and that of the resin part" is implicit in the summarized data in the provided tables. Therefore, there does not appear to be a written description of the new claim limitation in the application as filed. Applicant argues that the references alone, or in combination, fail to disclose every limitation of independent claims 99-102. Examiner respectfully disagrees. The key phrases in the claims is "or". Thus the pigment can be any of the listed materials. Further when the general conditions of a claim are disclosed in the prior art, obtaining the optimum or workable ranges would be obvious to one of ordinary skill (MPEP 2144.05). In response to applicant's argument that adding pigments to ceramics is not disclosed in a cited prior art reference, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., dispersing both carbon black and diamond in ceramics) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).